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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,263	09/10/2003	Benedicto H. Dominguez	VISAP073/P-13100	5063
75458 7590 08/28/2009 Beyer Law Group LLP/Visa P.O. BOX 1687 Cupertino, CA 95015-1687				
EXAMINER KUCAB, JAMIE R				
ART UNIT 3621		PAPER NUMBER		
NOTIFICATION DATE 08/28/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTOmail@beyerlaw.com

Office Action Summary

Application No.

10/660,263

Applicant(s)

DOMINGUEZ ET AL.

Examiner

JAMIE KUCAB

Art Unit

3621

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9-18, 20, 21, 23-37, 39-41, 44-47, 49, 50 and 52-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-18, 20, 21, 23-37, 39-41, 44-47, 49, 50, and 52-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 07/08/2009, 07/08/2009, 05/15/2009
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgements

1. Applicant's response filed March 17, 2009 is acknowledged.
2. Claims 1-7, 9-18, 20, 21, 23-37, 39-41, 44-47, 49, 50, and 52-55 are pending in the application. Claims 1-7, 9-18, 20, 21, 23-37, 39-41, 44-47, 49, 50, and 52-55 are examined below.
3. This Office action is given Paper No. 20090818 for reference purposes only.
4. Based on a comparison of the PGPub US 2004/0059688 A1 with Applicant's originally submitted specification, the PGPub appears to be a fair and accurate record of the Applicant's specification. Therefore, if necessary any references in this action to Applicant's specification refer to paragraph numbers in the PGPub.

Specification

5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 C.F.R. § 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the specification lacks antecedent basis for the claimed limitation "in real time."

Claim Objections

6. Claims 25, 29, and 52 are objected to for usage of the functional language "arranged to." It is believed that Applicant intends "arranged to" to mean "programmed

to" (or similar) since "arranged to" is functional language and, therefore, given less patentable weight. It is the Examiner's position that any general purpose computer with a network interface has a hardware configuration arranged to perform the recited functions with the appropriate programming. In light of the notice function of the claims, the Examiner respectfully requests changing "arranged to" to -- programmed to -- (or similar) where a positive recitation is desired. See also MPEP §2106 II. (C).

7. Claim 25 is objected to because of the following informalities: where Applicant recites "said presenter computer being further arranged to", it appears that Applicant intends to recite -- said presenter computer is further arranged to -- or similar. For the purpose of comparison with the prior art, the Examiner is taking it as such. Appropriate clarification or correction is required.

8. Claim 55 is objected to because of the following informalities: where Applicant recites "said trusted party computer being further arranged", it appears that Applicant intends to recite -- said trusted party computer is further arranged -- or similar. For the purpose of comparison with the prior art, the Examiner is taking it as such. Appropriate clarification or correction is required.

Claim Rejections - 35 USC § 112 1st Paragraph

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 1-7, 9-18, 20, 21, 23-37, 39-41, 44-47, 49, 50, and 52-55 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The “trusted party computer,” “presenter computer,” and “acceptor computer” are disclosed, however, the various functionalities of and various method steps performed by these computers were not previously disclosed, nor could antecedent basis be found in the specification.

Claim Rejections - 35 USC § 112 2nd Paragraph

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 1-7, 9-18, 20, 21, 23-37, 39-41, 44-47, 49, 50, and 52-55 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

13. Regarding claim 1, Applicant's recitations "A method ... during an on-line transaction" (preamble) and "receiving ... during an enrollment process" (lines 4-5) taken together would have been unclear to a person having ordinary skill in the art at the time of the invention. On one hand, the method appears to include the transaction process only. On the other hand, the method appears to also include an enrollment process ("receiving...", "verifying...", and "communicating") necessarily completed prior to the transaction process. For purposes of comparison with the prior art, the Examiner is interpreting the method to include both the enrollment process and the authentication process (contrary to what is implied by the preamble). Appropriate clarification - including, if possible, clarifying references to the specification - and/or correction is required. Claims 25, 37, and 52 are similarly confusing as to whether the method/system comprises both an authentication method/system or an enrollment and authentication method/system.

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects

for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

15. Claims 1-7, 9-18, 20, 21, 23-37, 39-41, 44-47, 49, 50, and 52-55, as understood by the Examiner in light of the above 112 2nd paragraph rejection, are rejected under 35 U.S.C. §102(e) as being anticipated by Dominguez et al. (US 2003/0200184 A1, hereinafter, Dominguez).

16. Regarding claims 1-7, 9-18, 20, 21, 23-37, 39-41, 44-47, 49, 50, and 52-55, Dominguez discloses (at least in Figs. 1 and 8 and the associated text) the claimed invention including:

- a. receiving, by said trusted party via the trusted party computer during an enrollment process, profile data and enrollment data from said presenter, said trusted party being an issuer of an account to said presenter and said presenter having transmitted said profile data to said trusted party ([0042], [0065]);
- b. verifying, by said trusted party during said enrollment process using said enrollment data, the identity of said presenter and associating authentication data with said presenter ("The trusted party can use a web-enabled, interactive "identity authentication service" provided by an outside entity during the enrollment process to help validate an account holder's identity," [0042]);
- c. communicating said authentication data ("password" or "token") between said trusted party and said presenter during said enrollment process, said authentication data being known only to said trusted party and to said presenter ([0065]);

- d. receiving said submitted profile data ("cardholder's primary account number") at said trusted party computer from said acceptor during said on-line transaction after said enrollment process, said submitted profile data being received by said acceptor from said presenter during said on-line transaction (steps 2 and 3, Fig. 8);
- e. comparing said submitted profile data against said profile data stored by said trusted party ("comparing the Account Identifier supplied in the two messages," [0130]);
- f. receiving, at said trusted party computer, submitted authentication data from said presenter during said on-line transaction; authenticating, by said trusted party computer, said presenter by comparing said submitted authentication data received from said presenter with said authentication data; validating, by said trusted party, said submitted profile data using results of said comparing and results of said authenticating (step 8, Fig. 8; [0131]);
- g. notifying said acceptor by said trusted party that said submitted profile data of said presenter is either authentic or erroneous, during said on-line transaction and in real time whereby said trusted party validates said submitted profile data of said presenter for the benefit of said acceptor (steps 9 & 10, Fig. 8; [0132]).

Claim Interpretation

17. Independent claims (1, 25, 37, and 52) are examined together. If Applicant expressly states on the record that two or more independent and distinct inventions are claimed in this application, the Examiner may require the applicant to elect an invention to which the claims will be restricted.

18. The USPTO interprets claim limitations that contain statements such as "*if, may, might, can, could, when, potentially, possibly*", as optional language (this list of examples is not intended to be exhaustive). As matter of linguistic precision, **optional claim elements do not narrow claim limitations**, since they can always be omitted (*In re Johnston*, 77 USPQ2d 1788 (Fed. Circ. 2006)). They will be given less patentable weight, because language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.

Response to Arguments

19. Applicant's arguments with respect to the §101 rejections of claims 25-36 and 52-54 have been fully considered, and they are persuasive. The §101 rejections of claims 25-36 and 52-54 have been withdrawn.

20. Applicant's arguments with respect to the §112, 1st paragraph rejections of the claims due to the trusted party computer have been fully considered, but they are only partially persuasive. The Examiner agrees that a trusted party computer is disclosed (access control server (ACS) 712, fig. 1). However, the Examiner must respectfully

disagree regarding disclosure of the functionality of and the method steps performed by the trusted party computer. Applicant cites to page 7, lines 14-26 of the specification as disclosing the functionality of and method steps performed by the trusted party computer, however, only lines 24-26 actually address functionality/steps of the trusted party computer. Lines 24-26 disclose only that the trusted party computer "is a computer system that controls access to the data authentication services program, performs the requested data services, and provides digitally signed notifications to acceptors regarding the data services." There is no mention in this citation of the function of "authenticating" or the various "receiving" steps/functionality recited in the claims. Therefore, the §112, 1st paragraph rejections of the claims due to the functionality of and method steps performed by the trusted party computer are maintained.

21. Applicant's arguments with respect to the §112, 1st paragraph rejections of the claims due to the limitation "in real time" have been fully considered, and they are persuasive. Therefore, the §112, 1st paragraph rejections of the claims due to the limitation "in real time" have been withdrawn.

22. Applicant's arguments with respect to the §112, 2nd paragraph rejections of the have fully been considered, but they are not persuasive. In order to unequivocally claim both the enrollment and transaction portions of the process, it is requested that Applicant amend the preamble to be consistent with the body of the claims by either (1) deleting "during an online transaction" from the preamble (as suggested by Applicant) or (2) amending the preamble to recite the enrollment process, e.g., -- A method involving

a presenter, a trusted party using a trusted party computer, and an acceptor for enrolling said presenter and validating submitted profile data of said presenter during an on-line transaction, said method comprising --. Until such amendment is made, the §112, 2nd paragraph rejections of the claims are maintained.

23. Applicant's argument with respect to the §102 rejections of the claims has been fully considered, and it is persuasive. The previous §102 rejections of the claims have been withdrawn.

24. Applicant's arguments with respect to the §103 rejections of the claims have been fully considered, and they are persuasive. The previous §103 rejections of the claims have been withdrawn.

Conclusion

25. Applicant's amendment filed March 17, 2009 necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

26. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

27. References considered pertinent to Applicant's disclosure are listed on form PTO-892. All references listed on form PTO-892 are cited in their entirety.

28. Because this application is now final, Applicant is reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. "The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted).

Furthermore, suggestions or examples of claim language provided by the Examiner are just that--suggestions or examples--and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is "allowed," exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not* been addressed with respect to other aspects of patentability (e.g. §101 patentable subject matter, §112 1st paragraph written description and enablement, §112 2nd paragraph indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

29. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Jamie Kucab whose telephone number is 571-270-3025. The Examiner can normally be reached on Monday-Friday 9:30am-6:00pm EST.

30. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

31. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JK

/ANDREW J. FISCHER/
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